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Attorney Docket No. GEMS8081.193

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Toth et al.
Serial No. : 10/605,789
Filed : October 27, 2003
For : METHOD AND APPARATUS OF RADIOGRAPHIC
IMAGING WITH AN ENERGY BEAM TAILORED FOR A
SUBJECT TO BE SCANNED
Group Art No. : 2882
Examiner : Chih-Cheng Glen Kao

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. The request is being filed with a Notice of Appeal. The review is requested for the reasons set forth hereinafter.

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REMARKS

Claims 1, 2, 5, 6, 8-14 and 16-23 are pending in the present application. In the Final Office Action mailed December 8, 2005, the Examiner rejected claims 1, 2, and 8-10 under 35 U.S.C. §103(a) as being unpatentable over Moore (USP 4,181,858). The Examiner next rejected claim 5 under 35 U.S.C. §103(a) as being unpatentable over Moore as applied to claim 1 above, and further in view of Popescu (USP 6,501,828). Claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over Moore and Popescu as applied to claim 5 above, and further in view of Hsieh (USP 5,970,112). Claims 11, 14 and 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Moore in view of Hoffman et al. (USP 6,137,857). Claims 12 and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Moore and Hoffman et al. as applied to claim 11 above, and further in view of Hsieh. Claims 17 and 19-21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Popescu in view of Toth et al (USP 6,307,918) and Moore. Claim 18 is rejected under 35 U.S.C. §103(a) as being unpatentable over Popescu, Toth et al, and Moore as applied to claim 17 above, and further in view of Gunji et al (JP 08-266523). Claims 22 and 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Popescu, Toth et al. and Moore as applied to claim 17 above, and further in view of Winter (USP 4,998,268).

On January 28, 2006, Applicant submitted a Declaration of Thomas L. Toth Under 37 C.F.R. §1.132 which provided rebuttal evidence to the *prima facie* case for obviousness. In that Declaration, Mr. Toth, as one skilled in the art, set forth evidence rebutting the Examiner's position that the claimed invention was a matter of design choice. In an Advisory Action mailed February 8, 2006, the Examiner concluded that the Toth Declaration was insufficient to rebut the *prima facie* case for obviousness.

Specifically, the Examiner asserted that the evidence accompanying the declaration was not commensurate in scope with the claims. However, the purpose of the declaration and evidence was to establish that the claimed invention was not a matter of design choice, as asserted by the Examiner. Accordingly, it is believed that the declaration is probative as to the non-obviousness of the claimed invention.

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As set for in the Advisory Action, the Examiner has also disagreed with the opinion evidence provided by Mr. Toth. In doing so, the Examiner has ignored the opinion of one skilled in the art. Moreover, the Examiner has apparently relied upon extraneous evidence to support the conclusion that the opinion of Mr. Toth is erroneous. The Examiner has not provided any information to substantiate that the extraneous evidence is the product of one skilled in the art. Additionally, the Examiner has not established that the extraneous evidence qualifies as prior art under 35 U.S.C. §102. Accordingly, the burden of the Examiner to rebut the Declaration of Thomas L. Toth has not been met. Mr. Toth's declaration establishes that the claimed invention is not a matter of design choice relative to the art of record. As one skilled in the art, absent countervailing evidence, Mr. Toth's opinion is too be given great weight. The Examiner has not provided any evidence that can be substantiated as of being from one skilled in the art to dispute the opinion of Mr. Toth. As such, it is believed that Applicant has provided ample evidence to rebut the *prima facie* case for obviousness.

Regarding the outstanding rejections, Applicant believes the Declaration of Thomas L. Toth establishes that the particulars of claimed invention are not merely a matter of design choice. The claimed invention and, in particular, the claimed orientation of the x-ray attenuating filters, results in advantages that were not expected nor suggested by the art of record. Specifically, as set forth previously, the acceptance angle of a detector cell sees more filter surface area if the curved portions of the filters face the detector which results in the detector receiving a greater amount of un-attenuated scatter from the surface of the filter. In short, the claimed orientation is more advantageous than the filter orientation disclosed and/or suggested by the art of record.

Regarding the rejection of claim 17, Applicant disagrees that the combination of Popescu, Toth et al., and Moore suggests the claimed invention. As set forth previously, Moore teaches away from the combination. The Examiner has asserted that Moore has only been relied upon for its teaching of "motors for filters"; however, it is well-established that "a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." MPEP §2141.02, VI citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721, F.2d 1540, 220

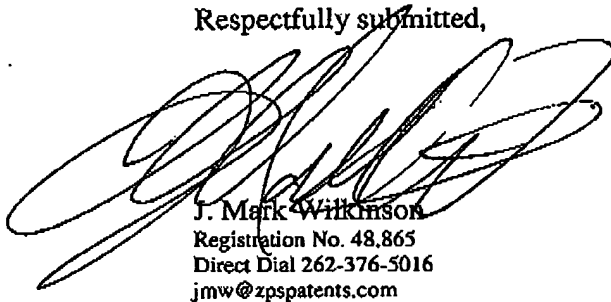
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USPQ 303 (Fed. Cir. 1983). As such, the Examiner must consider Moore in its entirety, not simply for its teaching of filter motors. In this regard, if Moore, as a whole, teaches away from a combination with a reference, one skilled in the art would not be motivated to form the combination notwithstanding that a particular portion of the disclosure may be combinable. Therefore, as Moore teaches that, at a minimum, its filter wedges overlap one another, a skilled artisan would conclude that it would be unnecessary to have a stationary filter, as called for in claim 17. Accordingly, it is believed that the art of record, *when considered in its entirety*, fails to teach or suggest the invention called for in claim 17.

Therefore, in light of at least the foregoing, Applicant believes that the pending claims define the claimed invention over the art of record and, as such, requests a pre-appeal review of the outstanding final rejections.

Respectfully submitted,



J. Mark Wilkinson
Registration No. 48,865
Direct Dial 262-376-5016
jmw@zpspatents.com

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Attorney Docket No.: GEMS8081.193

P.O. ADDRESS:
Ziolkowski Patent Solutions Group, SC
14135 North Cedarburg Road
Mequon, WI 53097-1416
262-376-5170